

## **REMARKS**

By the above amendment, Applicants have amended the specification to update the cross-reference to the parent application. Applicants have also amended the claims to more clearly define their invention. In particular, the claims have been amended to eliminate the alleged indefiniteness problems noted by the Examiner in numbered section 10 of the Office Action. Claim 1 has also been amended to recite that the continuous phase is an inorganic compound continuous phase; Pb and Al have also been excluded from the Markush group of elements comprising the composition. Applicants have also added claims 5-11 to define further aspects of the present invention. Claim 5 is supported by, e.g., the paragraph bridging pages 26 and 27 of Applicants' specification wherein it is disclosed that the composition can include more than two phases, e.g., a continuous phase and at least two discontinuous phases (contrary to the allegations made by the Examiner in numbered section 8 of the Office Action). Claims 6-11 are supported by, e.g., Table 1 on page 15 and the disclosure at, e.g., page 17, lines 17-26 of Applicants' specification.

The Examiner alleges in numbered section 3 of the Office Action that the Information Disclosure Statement filed September 26, 2003 fails to comply with 37 CFR 1.98(a)(2) since it does not include a legible copy of each cited foreign patent document. However, as noted in 37 CFR 1.98(d), such copies are not required if they were previously cited by or submitted to the office in a prior application, provided that the prior application is properly identified in the statement and relied upon for an earlier filing date under 35 U.S.C. 120. Since the foreign patent documents cited in the Information Disclosure Statement were previously cited by or submitted to the office in prior application serial number 09/622,480 and since the prior application is properly identified in the Information Disclosure Statement and is relied on for an earlier effective filing date under 35 U.S.C. 120, such copies were

not required. Therefore, the Examiner is requested to consider the Information Disclosure Statement.

In response to the objection to the drawings in numbered section 4 of the Office Action, Applicants are submitting herewith replacement sheets of drawings.

In view of the foregoing amendments to the claims, it is submitted all of the claims now in the application comply with the requirements under 35 U.S.C. 112, first and second paragraphs. Therefore, reconsideration and withdrawal of the rejections of the claims under 35 U.S.C. 112, first paragraph, in numbered section 8 of the Office Action and under 35 U.S.C. 112, second paragraph, in numbered section 10 of the Office Action are requested.

In response to the obviousness-type double patenting rejection in numbered section 12 of the Office Action, Applicants are submitting herewith a timely filed and properly executed Terminal Disclaimer. Accordingly, reconsideration and withdrawal of the double patenting rejection are requested.

The Terminal Disclaimer has been filed in order to advance the prosecution of the application and is not an admission of the propriety of the double patenting rejection.

Claims 1-3 stand provisionally rejected on the ground of obviousness-type double patenting as being unpatentable over claim 1 of copending application number 10/750,882. Applicants traverse this rejection and request reconsideration thereof.

The present invention is directed to a composition comprising an inorganic compound continuous phase and a discontinuous phase. On the other hand, claims 1-3 of copending application number 10/750,882 relate to a magnetic recording medium including a nanoparticle layer comprising an array of nanoparticles and an organic compound located between the array of nanoparticles. However, the copending application does not claim a composition comprising an inorganic compound continuous phase and a discontinuous phase, as presently claimed.

Moreover, it is submitted there would have been no motivation to modify the invention claimed in the copending application to arrive at the presently claimed invention. Therefore, claims 1-3 are not unpatentable over claim 1 of the copending application.

Claims 1-3 also stand provisionally rejected on the ground of obviousness-type double patenting as being unpatentable over claim 5 of copending application 10/832,310. Applicants traverse this rejection and request reconsideration thereof.

Claim 5 of copending application 10/832,310 relates to a nonlinear optical film containing at least two kinds of metals selected from a particular group as a principle component. However, claim 5 of the copending application does not claim a composition comprising an inorganic compound continuous phase and a discontinuous phase, as presently claimed. Accordingly, it is submitted that the presently claimed invention is patentable over claim 5 of the copending application.

Claim 1 stands rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 5,393,465 to Drozdyk et al. Claims 2 and 3 stand rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Drozdyk et al. Claim 4 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Drozdyk et al. Applicants traverse these rejections and request reconsideration thereof.

The Drozdyk et al. patent discloses a composition for making fired dielectric layers which is especially suitable for laser scribing, consisting essentially of finely divided particles of dielectric glass, inorganic filler having a refractive index higher than the glass and cobalt dioxide, all being dispersed in an organic medium. However, this patent does not disclose a composition comprising an inorganic compound continuous phase and a discontinuous phase, as presently claimed. Moreover, since the Drozdyk et al. relates to a composition used for making fired dielectric layers suitable for laser scribing, it is submitted there would have been no motivation to modify the composition disclosed therein to obtain the compound of the

present invention which has nonlinear optical characteristics. Accordingly, it is submitted the presently claimed invention is neither disclosed nor suggested by the Drozdyk et al. patent.

Claim 1 stands rejected under 35 102(b) as allegedly being anticipated by U.S. Patent No. 4,579,807 to Blonder et al. Claims 2 and 3 stand rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Blonder et al. Applicants traverse these rejections and request reconsideration thereof.

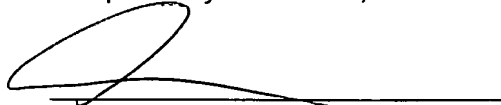
The patent to Blonder et al. relates to an optical disk including a medium having both a continuous phase and a non-continuous phase. The medium is disclosed the formed in one embodiment by simultaneously introducing a flux of at least two materials onto a deposition substrate. In a preferred embodiment, the material fluxes are produced by bombarding a target, e.g., a metal target such as indium, tin, copper, lead, or aluminum in a presence of a gas that reacts with the metal, e.g., oxygen and/or nitrogen. However, this patent does not disclose the composition presently claimed comprising an inorganic compound continuous phase and a discontinuous phase, and comprising at least one element selected from a group consisting of Co, Ti, V, Cr, Mn, Fe, Ni, Si and Bi. Accordingly, it is submitted the presently claimed invention is patentable over Blonder et al.

Applicants note the Examiner has cited a number of documents as being pertinent to Applicants' disclosure. However, since these documents were not applied and rejecting claims formerly in the application, further discussion of these documents is deemed unnecessary.

In view of the foregoing amendments and remarks, favorable reconsideration and allowance of all of the claims now in the application are requested.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (500.38802CX1) and please credit any excess fees to such deposit account.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'Alan E. Schiavelli', is written over a horizontal line.

Alan E. Schiavelli  
Registration No. 32,087  
ANTONELLI, TERRY, STOUT & KRAUS, LLP

AES/at  
(703) 312-6600

**IN THE DRAWINGS:**

Replace original sheets containing Figs. 6 and 7 with the attached replacement sheets. The replacement sheets more clearly show the details in Figures 6 and 7.